



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,546	06/22/1999	SHIGEKI HIROOKA	35.G2410	9128

5514 7590 03/19/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 03/19/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

52

Office Action Summary

Application No.

09/337,546

Applicant(s)

HIROOKA, SHIGEKI

Examiner

George C Neurauter

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 16 January 2003 have been fully considered but they are not persuasive.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

In regards to Applicant's argument that Thurlow does not teach wherein a type of each data included in the received email, wherein the received email includes a plurality of data, and in which it is determined whether each type of data included in the received email is to be utilized in accordance with the identified type of each data, the Examiner does not agree. Thurlow clearly discloses these limitations within the references made in the previous Office Action and in related references within the specification [column 6, lines 50-58; column 8, line 35-column 9, line 3].

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 10-22, 24-36, and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Thurlow et al. [US Patent 5 917 489 A].

Art Unit: 2143

Regarding claim 1, Thurlow discloses an e-mail processing method comprising the steps of: identifying a type of each data included in a received e-mail, the received email including a plurality of data; and determining whether each data included in the received e-mail is to be utilized in accordance with the identified type of each data. [column 6, lines 50-58; column 8, line 35-column 9, line 3; column 9, lines 15-61; column 10, lines 1-54]

Regarding claim 2, Thurlow discloses a method according to Claim 1, further comprising the steps of: registering an arbitrary type of data in advance; and determining that a data is to be utilized, when the identified type of data coincides with the registered type of data. [column 10, line 39-column 13, line 28]

Regarding claim 3, Thurlow discloses a method according to Claim 1, wherein, when it has been determined that a data is to be utilized, the email is preserved as a file. [column 12, lines 21-44, specifically Table II, the lines reading "File it in the designated folder" and "File a copy in the designated folder"]

Regarding claim 4, Thurlow discloses a method according to Claim 1, wherein, when it has been determined that a data is not to be utilized, the data is not preserved. [column 12, lines 21-44, specifically Table II, the line reading "Delete it"]

Regarding claim 5, Thurlow discloses a method according to Claim 1, wherein, when it has been determined that a data is not to be utilized, the data is read and then abandoned. [column 12, lines 21-44, specifically Table II, the line reading "File it in the designated folder"]

Regarding claim 6, Thurlow discloses a method according to Claim 5, wherein a presence of a data to be read and then abandoned is notified for external use. [column 6, lines 1-7; column 7, lines 15-22]

Art Unit: 2143

Regarding claim 7, Thurlow discloses a method according to Claim 1, wherein, when it has been determined that a data is not to be utilized, reception of the data is interrupted. [column 7, lines 54-65; column 16, lines 63-column 17, line 9]

Regarding claim 8, Thurlow discloses a method according to Claim 1, wherein a presence of a data that which has been determined not to be utilized is notified for external use. [column 12, lines 21-44, specifically Table II, the line reading "Notify me using a specific message"]

Regarding claim 10, Thurlow discloses a method according to Claim 1, wherein when it has been determined that a data is not to be utilized, a subsequent process is selectable from among a plurality of predetermined processes. [column 15, line 60-column 16, line 6]

Regarding claim 11, Thurlow discloses a method according to Claim 1, wherein the type of data comprises a text. [column 10, line 55-column 11, line 17, specifically Table I, the line reading "if the subject or body contain specific words"]

Regarding claim 12, Thurlow discloses a method according to Claim 1, wherein the type of data comprises an image. [column 10, line 55-column 11, line 17, specifically Table I, the line reading "if it has an attachment"]

Regarding claim 13, Thurlow discloses a method according to Claim 1, wherein identification of the type of data is performed by analyzing the received e-mail. [column 9, lines 14-16]

Regarding claim 14, Thurlow discloses a method according to Claim 1, wherein a character string is retrieved from the received e-mail, and the type of data is identified according to a reference character string specified based on a position in the received e-mail where the

Art Unit: 2143

retrieved character string is present. [column 7, lines 38-53; column 10, line 55-column 11, line 17, specifically Table I, the line reading "if the subject or body contain specific words"]

Claims 15-22, 24-36, and 38-40 are also rejected under 35 USC 102(e) since the claims are essentially identical. Claims 15-22 and 24-28 are essentially identical to claims 1-8 and 10-14 respectively, claims 29-36 and 38 are essentially identical to claims 1-8 and 10 respectively, and claims 39-40 are essentially identical to claims 13-14 respectively.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter whose telephone number is 703-305-4565. The examiner can normally be reached on Mon-Fri 9am-5:30pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the

Art Unit: 2143

organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

gcn

March 11, 2003



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100